

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Hideki ITO Confirmation No. 5422  
SERIAL NO. : 10/576,478  
FILED : April 20, 2006  
FOR : HEAT-SHRINKABLE POLYESTER FILM AND HEAT  
SHRINKABLE POLYESTER FILM ROLL  
GROUP ART UNIT : 1794  
EXAMINER : NELSON, Michael B.  
ATTY DOCKET NO. : 13241/15

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R. 1.132

SIR:

I, Hideki Ito, hereby declare as follows:

1. I graduated from Gifu Prefectural Tono High School in Japan.
2. I am currently employed at Toyo Boseki Kabushiki Kaisha as a member in film development department.
3. I have engaged in research and development in the field of film manufacturing department for 6 years, and in the field of film development department for 21 years.
4. I am an inventor for the above-identified patent application; I have read the Office Action mailed August 18, 2009 and the reference cited therein, Ito (US 6,451,445); and I am familiar with the subject matter thereof.
5. I have carried out and/or supervised the conduct of the following experiment and hereby submit my report thereon.

## **Experiment**

### **1. Experimental Procedures**

A polyester film was prepared according to Example 3 of Ito et al. (US 6,451,445; "Ito '445"), which is reproduced below:

#### **Example 3**

A heat shrinkable polyester film having a thickness of 50  $\mu\text{m}$  was obtained in a manner similar to that of Example 1 except using a polyester obtained by mixing together 6 wt % of Polyester A, 84 wt % of Polyester B and 10 wt % of Polyester C.

The obtained film was measured for the heat shrinkage percentage in a maximum shrinkage direction at 70 °C in a similar manner described in Ito '445, column 6, lines 32-45.

Also, the heat shrinkage percentage in a maximum shrinkage direction of the obtained film at 85 °C and  $\Delta X$  of the obtained film were measured as described in the present application (see pages 6-7 of the specification; claims 1-3).

### **2. Results**

The heat shrinkage percentage in a maximum shrinkage direction of the obtained film at 70 °C was 27%. Since Table 1 of Ito states that the heat shrinkage percentage along the main shrinkage direction of the film of Example 3 was also 27%, the film obtained in this experiment was a reproduction of the film of Example 3 of Ito '445.

The heat shrinkage percentage in a maximum shrinkage direction of the obtained film at 85 °C was 61%.

$\Delta X$  of the obtained film was 52%.

### **3. Conclusion**

The polyester film prepared according to Example 3 of Ito '445 did not satisfy requirements (B) or (C) of claim 1, which recite that the heat shrinkage percentage in a maximum shrinkage direction of the obtained film at 85 °C is not less than 75% and  $\Delta X$

is 10% to 20%, respectively.

Therefore, the polyester film of Ito '445 does not fall within the scope of claim 1. A film that does not satisfy requirement (C) does not have a small rate of change in a bottle diameter, producing insufficient container reinforcing effects.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the patent or any reexamination certificate issued therefor.

Dated: 2009.12.17

Hideki Ito  
[Name]